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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,704	06/16/2000	Paul A. Voois	8X8S.249PA	3460

40581 7590 08/03/2007
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EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
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2141

MAIL DATE	DELIVERY MODE
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08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/597,704

Applicant(s)

VOOIS ET AL.

Examiner

Kristie D. Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendments

Claim 3 has been amended.

Claims 1 - 22 are pending.

Response to Arguments

I. Applicant's arguments with respect to claims 1-22 have been considered but are unpersuasive due to the defective declaration, thus the rejection is maintained.

37 CFR 1.131 - AFFIDAVIT/DECLARATION

II. The declaration filed on January 16, 2007 under 37 CFR 1.131 has been considered is insufficient to overcome the *Brophy et al* reference.

A. FORMALITIES

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s),

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a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935). (MPEP 715.04)

In this case, the declaration includes the signature of the signing inventor, Paul

Voois, according to the petition filed under 37 CFR 1.47(a) which states that:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(g), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

Therefore, the signature of the first inventor, Paul Voois, is valid.

B. SUBSTANCE

Applicant is attempting to rely on reduction to practice prior to the effective date of the reference (*Brophy et al* on August 24, 1999).

CONCEPTION

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the

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exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). (MPEP 715.07)

In this case, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the *Brophy et al* reference.

Applicant relies on Exhibit A (supplemental to the exhibits submitted on 1/16/2007) to establish conception of the applicant's claimed invention. The exhibit is a descriptive document disclosing substantive evidence of the invention. The Examiner has reviewed the exhibit and is of the opinion that the exhibit does provide sufficient evidence to support the conception of the claimed invention, however, the exhibit fails to show that the redacted date is a date prior to the August 24, 1999. The exhibit is dated "30 November 1999" and it therefore is invalid to predate the effective data of the *Brophy et al* reference.

DILIGENCE

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a

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United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). (MPEP 715.07(a))

In this case, Applicant declares that both the conception and reduction to practice occurred before August 24, 1999, however this has not been established since the evidence is dated after August 24, 1999. Furthermore, diligence is lacking and there exists no proof of the actual reduction to practice prior to the effective date of the *Brophy et al* reference (including, no indications of repeated successful testing prior to the effective date of *Brophy et al*).

The Examiner notes that the substantive comments are merely for guidance and are not comprehensive. The affidavit is deficient on its face because of improper execution.

Claim Rejections - 35 USC § 112, second paragraph

III. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

IV. **Claims 1-22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) statements of intended use or field of use;
- (B) "adapted to" or "adapted for" clauses;
- (C) "wherein" clauses; and
- (D) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby"

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clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” Id. However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed.Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” Id. (*MPEP*, sections 2106 and 2111.04)

The claims listed above (dependent claims inherit the rejection from the independent claims) all recite “adapted to” clauses, which are non-limiting in scope and therefore should be corrected to in order to clearly specify the metes and bounds of the claimed invention and to define the inventive steps performed by the claimed elements.

Claim Rejections - 35 USC § 102

V. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

VI. **Claims 1 - 22 are rejected under 35 U.S.C. 102(e) as being anticipated by *Brophy et al* (US 6,782,412).**

a. **Per claim 1, *Brophy et al* teach a user-programmable communications arrangement including a computer having a display, the arrangement comprising:**

- a user interface (*col.2 lines 35-37, col.12 lines 53-56*); and
- a programmable controller (*col.2 lines 29-32 and 43-59, col.3 lines 21-36, col.4 lines 13-23*), the user interface and the programmable controller being adapted to:
- provide user-selected IP telephony configuration information to a control center communicatively coupled to a plurality of IP telephony devices (*col.2 lines 13-26,*

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col.3 lines 11-36, col.4 lines 13-23—provision for customer preferences and configurations to application and media server);

- display a control interface for at least one of: user control of an IP telephony device, office telephone administration control of a plurality of telephony devices, and system administrator control of telephony system configuration (*col.2 lines 32-37, col.9 line 64-col.10 line 8, col.12 lines 53-56—provision for a display user-interface for customer-defined control of an IP telephone device);* and
- the IP telephony configuration information being selected to control communications between, and to programmably configure, the control center and the plurality of IP telephony devices (*col.10 lines 49-65, col.15 line 15-col.16 line 36).*

b. **Per claim 15, Brophy et al** teach a user-programmable communications arrangement comprising:

- a user-interface device having a display, the device being adapted to provide IP telephony communications configuration information to a user via the display and to communicate IP telephony communications configuration selections from the user to a CPU (*col.7 line 48-col.8 line 4, col.10 lines 55-59, col.11 lines 39-44, col.11 line 62-col.12 line 2, col.12 lines 53-65, col.13 lines 46-49, col.14 lines 8-12, col.16 lines 12-14);* and
- a programmable CPU communicatively coupled to the user interface device and having an OOP interface coupled to an IP telephony communications link, the microprocessor being adapted to receive the IP telephony communications configuration selections from the user-interface device, and in response to the received selections, control selected functions of selected IP telephony devices of an IP telephony communications system via the IP telephony communications link (*col.2 lines 13-26 and 32-42, col.3 lines 11-36, col.4 lines 13-23, col.6 lines 30-35 and 41-48, col.7 lines 48-58, col.9 line 64-col.10 line 8, col.12 lines 53-56—provisions for customer preferences and configurations to application and media server, provisions for an OOP interface coupled to the IP telephony link and for customer-defined and preferenced control of selected IP telephone devices).*

c. **Claim 20** contains limitations that are substantially equivalent to claims 1 and 15, and is therefore rejected under the same basis.

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d. **Per claim 2**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the computer is adapted to announce an incoming call via the display, the call announce being effected without overtaking currently running applications (*col.13 line 64-col.14 line 12, col.14 lines 47-59*).

e. **Per claim 3**, *Brophy et al* teach the user-programmable communications arrangement of claim 2, wherein the call announce is effected using a locally-installed OOP applet that runs in the background of the computer (*col.6 lines 27-40, col.9 line 64-col.10 line 8, col.10 lines 49-65, col.13 line 64-col.14 line 12, col.14 lines 47-59*).

f. **Per claim 4**, *Brophy et al* teach the user-programmable communications arrangement of claim 2, wherein the call announce displays user control options including at least one of: caller ID, speaker phone, answer, forward to voicemail, hold, and call termination (*col.3 lines 17-20 and 55-61, col.8 lines 5-15, col.11 line 36-col.12 line 48, col.13 lines 50-63*).

g. **Per claim 5**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the user interface includes a graphic user interface (GUI) (*col.7 line 48-col.8 line 4, col.10 lines 55-59, col.11 line 62-col.12 line 2, col.12 lines 53-65, col.13 lines 46-49, col.14 lines 8-12*).

h. **Per claim 6**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the computer includes one of the plurality of IP telephony devices (*col.3 lines 21-38, col.5 lines 25-30, col.7 lines 42-47, col.11 lines 39-44, col.16 lines 12-14*).

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i. **Per claim 7**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the controller is adapted to access personal contact information (*col.3 lines 11-20, col.9 lines 45-51, col.10 line 66-col.11 line 7*).

j. **Per claim 8**, *Brophy et al* teach the user-programmable communications arrangement of claim 7, wherein the personal contact information is arranged in a searchable database accessible by the controller, the database being accessible via user-defined shuffle search statements (*col.9 lines 45-62, col.10 line 66-col.11 line 7*).

k. **Claim 17** is substantially similar to claim 8 and is therefore rejected under the same basis.

l. **Per claim 9**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the controller is adapted to provide a control interface for system administration control of an IP telephony network, the interface being adapted to provide at least one of: IP telephony system configuration and system status information (*col.2 lines 27-42, col.7 line 48-col.8 line 15, col.11 line 8-col.12 line 56, col.15 line 24-col.16 line 11*).

m. **Per claim 10**, *Brophy et al* teach the user-programmable communications arrangement of claim 9, wherein the IP telephony system status information includes at least one of: IP address assignment information for telephony devices, user-access security control level settings, current telephony device hardware settings, display settings for the controller, and telephony device location information (*col.3 lines 39-61, col.10 lines 30-49, col.11 lines 3-7, col.16 lines 12-36*).

n. **Per claim 11**, *Brophy et al* teach the user-programmable communications arrangement of claim 9, wherein the control interface is adapted to configure the IP telephony

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system to control at least one of: telephony device address assignment, user-access permissions, system report generation, display settings for the controller, voice mail parameters, IP telephony device hardware configuration, system backups, call routing protocol, call accounting, email configuration settings and call logging (*col.3 line 21-col.4 line 3, col.8 line 49-col.9 line 24, col.10 lines 30-49, col.11 lines 3-7, col.12 lines 7-52, col.12 line 65-col.13 line 2, col.16 lines 12-36*).

o. **Per claim 12**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein the computer is adapted to use OOP for providing the user-selected IP telephony configuration information to the control center (*col.2 lines 32-42, col.6 lines 30-35 and 41-48, col.7 lines 48-58, col.9 line 64-col.10 line 8*).

p. **Claims 16 and 19** are substantially similar to claim 12 and are therefore rejected under the same basis.

q. **Per claim 13**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein user control of an IP telephony device includes active call control and call receive settings including at least one of: speaker phone activation, call answer, call forward to voicemail, call forward to another number or IP telephony address, call hold, call termination, display of caller ID, speed dial, call transfer, redial, voicemail forwarding, voicemail messaging, multi-party calling call muting, video control, and remote access control for remote access to telephony services (*col.3 lines 17-20 and 55-61, col.8 lines 5-15, col.11 line 36-col.12 line 48, col.13 lines 50-63*).

r. **Per claim 14**, *Brophy et al* teach the user-programmable communications arrangement of claim 1, wherein each of the plurality of IP telephony devices includes a CPU,

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and wherein the user interface and controller are further adapted to: provide user-selected email configuration information to a control center communicatively coupled to each CPU; display a control interface for at least one of: user control of email configuration, office administration control of the plurality of CPUs, and system administrator control of email system configuration; and the email configuration information being selected to control communications between, and to programmably configure, the control center and the plurality of CPUs (*col.3 lines 21-38 and 61-66, col.5 lines 25-30, col.7 lines 42-47, col.9 lines 14-44, col.11 lines 1-7 and 39-44, col.12 lines 26-34, col.14 line 26-col.15 line 8, col.16 lines 12-14*).

s. **Per claim 18**, *Brophy et al* teach the user-programmable communications controller of claim 17, wherein the memory storage device is adapted to send display information to the user-interface device using OOP, the display information including available IP telephony communications selections (*col.2 lines 32-42, col.6 lines 30-35 and 41-48, col.7 lines 48-58, col.9 line 64-col.10 line 8, col.11 lines 33-48*).

t. **Per claim 21**, *Brophy et al* teach the user-programmable communications control system of claim 20, wherein the scope of communications control selections that can be made at the computer station is controlled by the programmable communications server based on a predefined user-access permission level (*col.7 lines 59-col.8 line 4, col.8 lines 49-60, col.10 lines 38-48, col.11 line 33-col.12 line 65*).

u. **Per claim 22**, *Brophy et al* teach the user-programmable communications control system of claim 20, further comprising a plurality of computer stations, wherein programmable communications server is adapted to receive communications control selections from each of the

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plurality of computer stations (*col.2 lines 13-26, col.3 lines 11-38, col.4 lines 13-23, col.5 lines 25-30, col.7 lines 42-47, col.11 lines 39-44, col.16 lines 12-14*).

Conclusion

VII. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Miloslavsky (5970065), Norris et al (5805587), Srinivasan (6907449), Lu et al (6611590), Petty et al (6337858), Farris et al (6125113), Allan et al (7068641).

VIII. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday 8:00am-5:30pm.

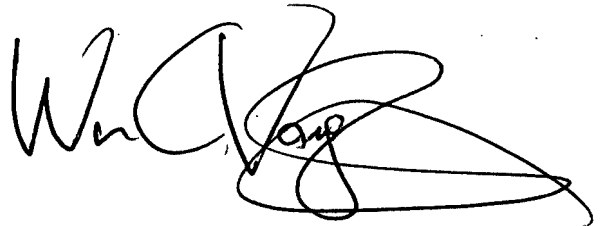
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie D Shingles
Examiner
Art Unit 2141

kds

A handwritten signature in black ink, appearing to read 'Kristie D Shingles', with a large, stylized flourish at the end.